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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,366	01/25/2002	Johannes M.M. Verbakel	PHQ 98,017A	8305

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

CHU, KIM KWOK

ART UNIT PAPER NUMBER

2627

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,366	<b>Applicant(s)</b> VERBAKEL ET AL.	
	<b>Examiner</b> Kim-Kwok CHU	<b>Art Unit</b> 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief filed on 12/12/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-28,31,32,36-38,40 and 42 is/are allowed.
- 6) ☒ Claim(s) 10 and 35 is/are rejected.
- 7) ☒ Claim(s) 29,30,33,34,39 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/328,024.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Remarks***

1. Applicant's Appeal Brief filed on December 12, 2005 have been fully considered.

(a) With respect to the judicially created doctrine of obviousness-type double patenting, Claims 10 and 35 are unpatentable over claim 2 of the U.S. Patent 6,370,090.

***Claim Objections***

2. Claims 29, 30, 33, 34, 39 and 41 are objected to because of the following informalities:

(a) in claim 29, line 4, the term "driving the track" should be changed to --driving the disc--; and

(b) similarly, in claim 33, line 4, the term "driving the track" should be changed to --driving the disc--.

Appropriate correction is required.

3. Claims 30, 34, 39 and 41 are objected because of its dependence on an objected claim.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 10 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,370,090.

Although the conflicting claims are not identical, they are not patentably distinct from each other. For example, with respect to the present claim 10, the '090 patent shows the following features:

(a) in claim 10, a method for producing a unitary storage medium ('090 patent; claim 1, line 1);

(b) in claim 10, providing at least two mutually logically conforming sub-TOCs for the same track area (abutting

at opposite end of their associated Track Areas) in one or more track areas of a unitary storage medium ('090 patent; claim 2);

(c) as in claim 10, providing at least one master-TOC having structures for storing information for determining the position of the sub-TOCs ('090 patent; claim 1, lines 10 and 11); and

(d) as in claim 10, the additional sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs ('090 patent, claim 1, the correct copy of the Sub-TOC contains the same information items).

6. Claim 35 is rejected for the same reasons relied on above.

**Allowable Subject Matter**

7. Claims 10-42 are allowable over prior art.

8. The following is an Examiner's statement of reasons for the indication of allowable subject matter based on Appeal Brief filed on December 12, 2005.

As in claims 10, 22, 31 and 35 the prior art of record fails to teach or fairly suggest a method for producing a unitary storage medium having the following features:

(a) providing at least two mutually logically conforming sub-TOC in one or more track areas of a unitary storage medium;

(b) the sub-TOCs having a structure for storing information for determining the configuration of the items stored in the track area;

(c) the sub-TOCs having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs; and

(d) providing at least one master-TOC having structures for storing information for determining the position of the sub-TOCs.

As in claims 25, 27, 29 and 33, the prior art of record fails to teach or fairly suggest an apparatus for controlling a reading device having the following features:

(a) providing at least two mutually logically conforming sub-TOC in one or more track areas of a unitary storage medium;

(b) the sub-TOCs having a structure for storing information for determining the configuration of the items stored in the track area;

(c) the sub-TOCs having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs; and

(d) a control means for positioning a read head for reading sub-TOC depending on position information read from at least one master-TOC.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

9. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry. Or:

(571) 273-7585, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application should be directed USPTO Contact Center (703) 308-4357; Electronic Business Center (703) 305-3028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

Kim-Kwok CHU

*kc 3/20/06*  
Examiner AU2653  
March 20, 2006

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